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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,181	11/10/2000	Steven D. Jensen	7678.350.2	4245
22913	7590	01/27/2010		
Workman Nydegger 1000 Eagle Gate Tower 60 East South Temple Salt Lake City, UT 84111			EXAMINER PRYOR, ALTON NATHANIEL	
			ART UNIT	PAPER NUMBER
			1616	
			MAIL DATE	DELIVERY MODE
			01/27/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 09/710,181	Applicant(s) JENSEN ET AL.
Examiner ALTON N. PRYOR	Art Unit 1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 November 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Alton N. Pryor/
Primary Examiner, Art Unit 1616

The Examiner reiterates that McLaughlin in Example 4 disclose a composition comprising 10% hydrogen peroxide and 1% potassium nitrate. The Examiner maintains that Example 4 of McLaughlin reads on the instant independent claims with respect to % amounts of peroxide and potassium nitrate. The Examiner maintains that the Applicants only provide unexpected results for a composition comprising 0.5% potassium nitrate and 10.5% carbamide peroxide (see pages 26-28 of instant specification or pages 15-16 of Applicants' reply filed 6/2/09). The Examiner reiterates that the Applicants have not provided unexpected data for the % ranges of potassium nitrate or for the % ranges and types of peroxides claimed. Since the prior art disclose an invention comprising 1% potassium nitrate and 10% hydrogen peroxide, it would have been obvious to develop the instant invention in light of McLaughlin (i.e. it would have been obvious to make an invention comprising the instant % amount ranges of potassium nitrate and peroxide). For this reason, the Applicants' argument regarding the trends of claimed % ranges for potassium nitrate and peroxide is not convincing, and therefore, it is imperative that Applicants claim unexpected results or provide ample unexpected results to cover the scope of % ranges recited in the claims. Thus, the unexpected result provided on pages 26-28 is not commensurate in scope with the instant claims.

The Applicants argue that instant claims are to an invention substantially free of abrasives, i.e. the amount of abrasive in the invention is less than 20%. Applicants argue that McLaughlin's composition must contain more than 20% abrasive in the paste carrier. Toothpastes contain abrasives (column 3 lines 50-61, column 7 lines 22-26, column 3 lines 37-49, sci-toys.com/ingredients/toothpaste.html and www.healthnews.com/dental-health/toothpaste-three-difference-200.html). The Examiner argues that McLaughlin does not disclose an abrasive in his composition of Example 4. McLaughlin does not teach or suggest that the paste carrier therein for the composition comprise an abrasive. Therefore, McLaughlin meets the instantly claimed limitation of the present invention comprising substantially no abrasive (less than 20% abrasive). The Examiner awaits evidence from the Applicants supporting that McLaughlin's composition in Example 4 contains an abrasive and the amount thereof if present). Applicant argues that all of McLaughlin's toothpaste composition would contain abrasives. The Examiner reiterates that McLaughlin's Examiner 4 does not list an abrasive. Note, instant claims are not free of abrasive. The Examiner argues that the bleaching agent appears to be the key element for the invention. The Examiner maintains that the Applicants' results provided for compositions comprising 10.5 and 15 % bleaching agents would not represent the broad range of about 3% to about 30% bleaching agent since McLaughlin teaches a composition comprising 10% bleaching agent and 1% potassium nitrate. This teaching of McLaughlin also reads on the claimed composition comprising 10 to 20 % bleaching agent.

The Examiner argues that McLaughlin only exemplifies a toothpaste. However, McLaughlin teaches that the disclosed and suggested composition can be used in a dental tray that can be applied to teeth (column 4 line 59 - column 5 line 15). McLaughlin also teaches that the disclosed and suggested composition therein may comprise solvents and tackifying agent (column 3 lines 38-61).

The term toothpaste denotes an abrasive composition used to clean teeth when brushing. McLaughlin does not teach or suggest a dental formulation comprising a dental bleaching agent in the claimed amount and a carrier that contains a solvent and a tackifying agent to yield a bleaching composition free of abrasives.

The method steps in claims 72-85 are not suggested or taught by McLaughlin. The step of contacting a person's teeth with the dental bleaching composition (without scrubbing or brushing) for a sufficient time to bleach teeth is not taught by McLaughlin.

The Examiner argues that McLaughlin teaches that the disclosed and suggested composition can be used in a dental tray to be applied to teeth (column 4 line 59 - column 5 line 15). Such an application would not involve brushing or scrubbing the teeth.

Claims 41, 42, 44-48, 50-87, 91-93 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6306370. The Examiner reiterates that the claims are not commensurate in scope with the showings in the Fischer's declaration. The claims recite a range of 3-30% peroxide and applicants' declaration only shows results for ranges of peroxide being

In the comparison of Applicants' claims with USPN '370 claims, the claims in USPN '370 makes obvious instant claims. Note instant claims to composition comprising 10% to about 30 % peroxide overlaps USPN's peroxide range of about 3% to about 20% peroxide. Note that instant claims to composition comprising about 0.05 to about 1 % potassium nitrate fall within the range (about 0.01 to about 10%) claimed in USPN '370. Therefore, USPN '370 claims makes obvious the instant claims. Applicants provide unexpected for a composition comprising 10 or 15 % peroxide and 0.5 % potassium nitrate (see evidence appendix). As recited in office action of 4/5/2005, the Examiner agrees that results are convincing as well as unexpected. However, the Examiner maintains that the claims are not commensurate in scope with the examples tested. For this reason, the rejection is maintained. Applicants argue that the criticality of the invention lies within the amount of potassium nitrate not in the amount of peroxide. This may be true, however, this statement is not convincing since Applicants only provide data for 10% and 15% peroxide in the broad range of about 3 to about 30% peroxide instantly claimed. For the above reasons USPN '370 is cited as an obviousness-type double patenting rejection over instant claims. The data are not commensurate in scope with the Examples provided at pages 26-28 of the specification. The claimed ranges of 0.05 - 1 % potassium nitrate and 10 - 30% carbamide peroxide are not commensurate in scope with the unexpected results since the only data point tested involves a composition comprising 0.5% potassium nitrate and 10.5% carbamide peroxide.